



PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Case No. 00-387-P)

In re Application of:)
)
 Benkovic et al.)
) Group Art Unit: 1623
 Serial No.: 10/615,703)
) Examiner: TBD
 Filing Date: July 9, 2003)
)
 For: Treatment of Bacterial Induced Diseases)
 Using DNA Methyl Transferase Inhibitors)

Mail Stop MISSING PARTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION UNDER 37 C.F.R. 1.47(a)
TO ALLOW SIGNATURE ON BEHALF OF
INVENTOR WHO CANNOT BE REACHED**

Dear Sir:

Pursuant to 37 C.F.R. § 1.47(a), the Applicants respectfully request the Office to allow the signing inventors Mr. Stephen J. Benkovic ("Mr. Benkovic"), Ms. Lucy Shapiro ("Ms. Shapiro"), Mr. Craig Stephens ("Mr. Stephens"), Ms. Lyn Sue Kahng ("Ms. Kahng"), Mr. Anthony Berdis ("Mr. Berdis") and Ms. Irene Lee ("Ms. Lee"), to make application on behalf of themselves and co-inventor Ms. Rachel Wright ("Ms. Wright"), who cannot be reached.

In support of this Petition, I, Kevin E. Noonan, declare as follows with respect to U.S. Patent Application Serial No. 10/615,703 ("present Application"), entitled "Treatment of Bacterial Induced Diseases Using DNA Methyl Transferase Inhibitors." I am an attorney at the law firm McDonnell, Boehnen, Hulbert and Berghoff LLP ("MBHB"), and an outside counsel representative for Applicants, The Penn State Research Foundation and The Board of Trustees of Leland Stanford Jr. University. I have personal knowledge of the following facts, and if called to testify, I would and could testify competently to the matters set forth herein.

06/24/2004 MAHME1 00000067 10615703

02 FC:1460

130.00 OP

1. As noted, Mr. Benkovic, Ms. Shapiro, Ms. Wright, Mr. Stephens, Ms. Kahng, Mr. Berdis and Ms. Lee are named as joint inventors on the present Application.
2. The present Application claims priority to International Patent Application Serial No. PCT/US97/16593, published March 26, 1998 under number WO 98/12206. Mr. Benkovic, Ms. Shapiro, Ms. Wright, Mr. Stephens, Ms. Kahng, Mr. Berdis and Ms. Lee are named inventors in Application PCT/US97/16593. A copy of the cover page for published application WO 98/12206 is attached hereto as Exhibit A.
3. The present Application also claims priority to US Non-Provisional Patent Application Serial No. 09/269,137, which is a '371 national phase filing of PCT/US97/16593, and which issued as US Patent Number 6,413,751 on July 2, 2002. Mr. Benkovic, Ms. Shapiro, Ms. Wright, Mr. Stephens, Ms. Kahng, Mr. Berdis and Ms. Lee are named inventors in Application 09/269,137. A copy of the cover page for US Patent 6,413,751 is attached hereto as Exhibit B.
4. Ms. Wright executed an assignment and agreement for the invention to which application 09/269,137 is directed. In the executed assignment and agreement, she:
 - a. sold, assigned and transferred to The Board of Trustees of the Leland Stanford Jr. University as assignee, and its successors, assigns and legal representatives, the entire right, title and interest, for all countries in and to certain inventions relating to DNA Adenine Methyltransferases and Uses Thereof described in an application for Letters Patent of the United States, filed as U.S. Serial No. 09/269,137 on 07/19/1999 and all the rights and privileges under any and all Letters Patent that may be granted therefore;
 - b. requested that any and all patents for said inventions be issued to said assignee, its successors, assigns and legal representatives, or to such nominees as it may designate;
 - c. agreed that, when requested, they will without charge to said assignee but at its expense, sign all papers, take all rightful oaths, and do all acts which may be

necessary, desirable or convenient for securing and maintaining patents for said inventions in any and all countries and for vesting title thereto in said assignee, its successors, assigns and legal representatives or nominees; and

- d. authorized and empowered said assignee, its successors, assigns and legal representatives or nominees, to invoke and claim for any application for patent or other form of protection for said inventions filed by it or them, the benefit of the right of priority provided by the International Convention for the Protection of Industrial Property, as amended, or by any convention which may henceforth be substituted for it, and to invoke and claim such right of priority without further written or oral authorization from her.

This assignment and agreement was recorded on August 26, 1999 at reel/frame number 010195/0981.

5. Mr. Benkovic, Ms. Shapiro, Ms. Wright, Mr. Stephens, Ms. Kahng, Mr. Berdis and Ms. Lee also executed a Declaration for Patent Application for application 09/269,137, which issued as US Patent 6,413,751 on July 2, 2002.
6. To date, only Mr. Benkovic, Ms. Shapiro, Mr. Stephens, Ms. Kahng, Mr. Berdis and Ms. Lee have executed and returned to MBHB a combined Declaration and Power of Attorney for the present Application.
7. Ms. Wright no longer works at Stanford University and never worked at Penn State University.
8. The last known home address for Ms. Wright is 1022 Mallet Court, Menlo Park, CA 94025.
9. The undersigned declares that a diligent effort was made to obtain a signed combined Declaration and Power of Attorney for the present Application from Ms. Wright. The facts proving this effort are as follows:
 - a. On May 7, 2004, I had Ms. Gwen Benoy, a paralegal at MBHB, send to Ms. Wright via United States Postal Service express mail to her last known home address a

copy of the filing receipt for the present Application, and a combined Declaration and Power of Attorney. A cover letter with instructions and a request to execute and return the documents was included.

- b. On June 4, 2004, the express mail package containing cover letter and documents sent on May 7, 2004 was returned to MBHB, marked "unclaimed". On the receipt it is noted that delivery attempts were made on 5/8/04 and 5/10/04. A copy of the returned express mail receipt is attached along with the cover letter of the mailing, as Exhibit C.
 - c. On May 11, 2004, I instructed Ms. Gwen Benoy, a paralegal at MBHB, to contact co-inventor Ms. Shapiro. Ms. Wright's post-doctoral work was done at Stanford University with Ms. Shapiro and Mr. Stephens. Ms. Shapiro informed Ms. Benoy that Ms. Wright has moved back to her native country, New Zealand, and the Stanford group does not have current address information for Ms. Wright.
10. Since Ms. Wright has not signed and returned the combined Declaration and Power of Attorney, the combined Declaration and Power of Attorney shown in Exhibit B includes an empty signature block for Ms. Wright. The Applicants believe that this satisfies the requirement of 37 C.F.R. § 1.47(a) that all the available joint inventors must (1) make oath or declaration on their own behalf as required by 37 CFR §§ 1.63 or 1.175 and (2) make oath or declaration on behalf of the nonsigning joint inventor as required by 37 CFR § 1.64. See M.P.E.P. § 409.03(a)(A), which states "An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the available joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated."
11. Applicants Penn State Research Foundation and The Board of Trustees of Leland Stanford Jr. University will suffer irreparable harm if not allowed to apply for a patent for the above-listed Application because that the United States Patent and Trademark Office will otherwise hold the present Application abandoned without an executed Oath or Declaration.
12. I hereby declare that all statements made herein are of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these

statements were made with the knowledge that willful false statements and the like so made under penalty of perjury and that such willful false statements may jeopardize the validity of the specification or any patent issued thereon, and that this affidavit was executed on the 15th day of June 2004 in Chicago, Illinois, United States of America.

13. Pursuant to 37 C.F.R. §§ 1.47(a) and 1.17(h), Applicants submit herewith a check for the petition fee of \$130.

Respectfully submitted

**McDONNELL BOEHNEN
HULBERT & BERGHOFF LLP**

Date: June 15, 2004

By: 

Kevin E. Noonan
Reg. No. 35,303

PCTWORLD INTELLECTUAL PROPERTY ORGANIZATION
International Bureau

INTERNATIONAL APPLICATION PUBLISHED UNDER THE PATENT COOPERATION TREATY (PCT)

(51) International Patent Classification ⁶ : C07H 21/04, 21/02, C12N 15/63, 15/85, 9/10, C12Q 1/68, 1/48, G01N 33/567, C07K 16/40	A1	(11) International Publication Number: WO 98/12206 (43) International Publication Date: 26 March 1998 (26.03.98)
(21) International Application Number: PCT/US97/16593 (22) International Filing Date: 17 September 1997 (17.09.97) (30) Priority Data: 60/020,089 19 September 1996 (19.09.96) US (71) Applicants (for all designated States except US): THE BOARD OF TRUSTEES OF LELAND STANFORD JR. UNIVERSITY [US/US]; Stanford University, 105 Encina Hall, Stanford, CA 94305 (US). THE PENN STATE RESEARCH FOUNDATION [US/US]; 304 Old Main, University Park, PA 16802 (US). (72) Inventors; and (75) Inventors/Applicants (for US only): SHAPIRO, Lucy [US/US]; 724 Esplanada Way, Stanford, CA 94305 (US). BENKOVIC, Stephen, J. [US/US]; 771 Teaberry Lane, State College, PA 16803 (US). WRIGHT, Rachel [NZ/US]; 1022 Mallet Court, Menlo Park, CA 94025 (US). STEPHENS, Craig [US/US]; 339 Anna Avenue, Mountain View, CA 94043 (US). KAHNG, Lyn, Sue [US/US]; 1200 Dale Avenue #125, Mountain View, CA 94040 (US). BERDIS, Anthony [US/US]; 2077 Mary Ellen Lane,	(74) Agents: WEBER, Kenneth, A. et al.; Townsend and Townsend and Crew LLP, 8th floor, Two Embarcadero Center, San Francisco, CA 94111 (US). (81) Designated States: AL, AM, AT, AU, AZ, BA, BB, BG, BR, BY, CA, CH, CN, CU, CZ, DE, DK, EE, ES, FI, GB, GE, GH, HU, ID, IL, IS, JP, KE, KG, KP, KR, KZ, LC, LK, LR, LS, LT, LU, LV, MD, MG, MK, MN, MW, MX, NO, NZ, PL, PT, RO, RU, SD, SE, SG, SI, SK, SL, TJ, TM, TR, TT, UA, UG, US, UZ, VN, YU, ZW, ARIPO patent (GH, KE, LS, MW, SD, SZ, UG, ZW), Eurasian patent (AM, AZ, BY, KG, KZ, MD, RU, TJ, TM), European patent (AT, BE, CH, DE, DK, ES, FI, FR, GB, GR, IE, IT, LU, MC, NL, PT, SE), OAPI patent (BF, BJ, CF, CG, CI, CM, GA, GN, ML, MR, NE, SN, TD, TG). Published <i>With international search report.</i> <i>Before the expiration of the time limit for amending the claims and to be republished in the event of the receipt of amendments.</i>	
(54) Title: DNA ADENINE METHYLTRANSFERASES AND USES THEREOF (57) Abstract <p>The present invention relates to the isolation and sequencing of a novel class of methyltransferase genes, including the methyltransferase gene from <i>Rhizobium meliloti</i>, <i>Agrobacterium tumefaciens</i>, <i>Brucella abortus</i>, and <i>Helicobacter pylori</i>. The invention further comprises efficient methods of assaying methyltransferase activity.</p>		



McDonnell Boehnen Hulbert & Berghoff
Law Offices

300 South Wacker Drive
Chicago, Illinois 60606-6709
www.mbhb.com

312 913 0001 phone
312 913 0002 fax

May 7, 2004

Rachel Wright
1022 Mallet Court
Menlo Park, CA 94025

Re: US Patent Application filed July 9, 2003
Treatment of Bacterial Induced Diseases Using DNA Methyl Transferase Inhibitors
Owners: Penn State University and Stanford University
Inventors: Benkovic et al.
Our Reference No. 00-387-P

Dear Ms. Wright:

Enclosed is a copy of the U.S. Patent Office filing receipt for the above-referenced U.S. and PCT Patent Applications. The application was filed on July 9, 2003 and given Serial No. 10/615,703.

Also enclosed are formal papers for your signature. The Declaration and Power of Attorney is due on **May 15, 2004**. Please sign and date the Declaration where indicated. If any information in the Declaration regarding is incorrect (e.g., your postal address), please make the correction in permanent ink and then initial and date the correction. As soon as possible after receipt of this letter, kindly return the signed document in the enclosed pre-paid Express Mail envelope.

The enclosed Assignment should be executed before a notary public. You may return this document at your convenience, in case you do not have easy access to a notary public. The other document requires only your signature and must be returned before the due date noted above.

We remind you that under the U.S. Patent Laws, each person associated with the filing and prosecution of a patent application (including inventors and attorneys) has a duty of candor and good faith in dealing with the Office, including disclosing to the Patent Office all information of which the person is aware that may be considered by an Examiner to be

"material" to patentability. We enclose an information sheet regarding this Duty of Disclosure. As described, please provide us with copies of all publications and other information known to you that may be material to patentability. We will then submit that information to the PTO in an Information Disclosure Statement.

If you have any questions, you are welcome to contact us.

Sincerely,

A handwritten signature in black ink that reads "Gwen Benoy". The signature is fluid and cursive, with the first name "Gwen" and last name "Benoy" clearly distinguishable.

Gwen Benoy
Paralegal
312 913 0001 ext 2006
benoy@mbhb.com

cc: Kevin E. Noonan